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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,911	06/26/2003	Eugene H. Carlson	55313US010	5716
32692	7590	06/13/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,911

Applicant(s)

CARLSON ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-26 is/are allowed.
- 6) ☒ Claim(s) 12-14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 13 Jan 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1734

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US Patent No. 5,916,399) in view of Orensteen et al. (US Patent No. 5,706,133).

Olsen discloses a retro reflective transfer sheet material where carrier (16) includes a plurality of discrete segments (20, 24) with an adhesive surface (28) and the viewing surface (26) being attached to the carrier (16). The adhesive surface (28) is applied to the substrate (30). (Figures 1 and 2; Col. 8, lines 6-24.)

Olsen does not disclose protecting the adhesive (28) with a release surface.

Orensteen discloses making retro reflective articles where the articles are fed in a roll of sheeting (20) and transferred to the substrate at a station (300). In particular it is important to note that the resulting retro reflective article is stored in roll form. (See Fig 3.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to feed the material in Olsen in roll form as shown in Orensteen, because a roll of articles adhered to a sheet is a well known method of storing and then feeding flexible articles to be transfer. As such, the adhesive of the articles in Olsen would be protected by the carrier until the article is unrolled.

Regarding claim 13, Olsen in view of Orensteen includes a supply roll.

Regarding claim 14, when the article is unrolled, a release liner is removed.

Art Unit: 1734

Regarding claim 16, where carrier is removed, a major viewing surface is exposed.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen in view of Orensteen as described above with respect to claims 12, 18, and 21 above, and further in view of Bacon, Jr. et al. (US Patent No. 6,508,559).

Olsen in view of Orensteen does not disclose the extensibility of the carrier web.

Bacon, Jr. discloses that it is known in the art to have an extensible carrier web, especially when the material is meant to be "conformable."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an extensible carrier web in the method of Olsen in view of Orensteen, because of the teaching in Bacon where an extensible carrier web helps in the transfer process.

#### ***Allowable Subject Matter***

4. Claims 18-26 are allowed.

5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is an examiner's statement of reasons for allowance:

Regarding claim 15, reasons set forth in previous Office Action dated 20 Aug 2004.

Regarding claims 18-26, there is no suggestion in the prior art to modify the references presented above to include the features as set forth in the newly amended claims. Further discussion of these features are set forth in applicant's arguments dated 20 Oct 2004.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany

Art Unit: 1734

the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

7. Applicant's arguments filed 17 February 2005 have been fully considered but they are not persuasive.

8. As set forth above Olsen discloses a retro reflective transfer sheet material where carrier includes a plurality of discrete segments (20, 24). These segments, as seen clearly in Figures 1 and 2 are spaced apart a distance. It is also appreciated that when the flexible substrate is bent a predetermined amount, for instance around a column or mandrel, the articles would not contact but instead be pulled apart.

9. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant states how neither references recognize the problem addressed by their invention, but they fail to point the language in the claims which detail this invention. Olsen discloses the segments as spaced apart, so how does this not recognize that they should spaced apart?

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

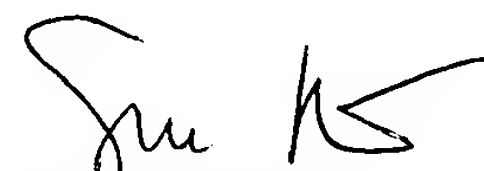
Art Unit: 1734

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
June 9, 2005